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Serial No.: 10/003,656
Art Unit 1617

REMARKS

The Office Action mailed December 24, 2001 has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. Applicant has elected the single species of a polyisobutenylsuccinic anhydride with methyltriglycol. Accordingly, Applicant has amended the claims remaining in the case to be consistent with the elected species for prosecution on the merits, such that the remaining claims in the case read upon the elected species. Reconsideration of the present Application in view of the following remarks is respectfully requested.

Applicant has amended the Application to attend to housekeeping matters and to more clearly describe the invention. Claim 10 was amended to more clearly state that the present invention is directed to a "cosmetic composition which comprises a fragrance", and amended to replace the term "derivative" with the term -esters-, and amended to recite that the alkenylsuccinic anhydride comprises an alkenyl chain selected from the group consisting of ethylene, propylene, butene, and isobutene and that the alkenylsuccinic anhydride ester is obtained by reaction of the alkenylsuccinic anhydride with a mono- and/or polyfunctional alcohol. Claims 3, 15 and 21-24 were amended to depend from claim 10. Claim 3 was further amended to recite that the alkenylsuccinic anhydride comprises a polyisobutenyl chain obtainable by polymerization of isobutene, or a mixture of isobutene and butene. Support for this amendment may be found in originally filed claim 3 and claim 2. Claims 14-21 were amended to consistently refer to the mono- and/or polyfunctional alcohols of which the methyltriglycol is a member. Support for these amendments may be found in Applicant's Specification in page 8, paragraph [0039] and originally filed claims 10-24. New claim 25 recites a pharmaceutical composition comprising a pharmaceutical active ingredient. Support for new claim 25 may be found in originally filed claim 1 and in Applicant's Specification at page 14, paragraph [0064].



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New claims 26-27 depend from claim 25 and include the limitations of originally filed claims 14, 15, and 18. New claim 29 recites a cosmetic composition which is free of fragrance comprising an additive selected from the list of cosmetic additives presented in Applicant's Specification on page 8, paragraph [0038]. It is not believed that any new matter was introduced by these amendments, and that no additional search is required by the office.

Claim 3, 10, 14-15, 18 and 20-24 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention in claim 2 for the use of the term "derivative" and in claim 14 for the term "blocklike". As amended, claim 11 now clearly recites an ester rather than a derivative, and the term "blocklike" was replaced with the term --block-- in describing the type of copolymers of ethylene oxide and propylene oxide. Therefore the rejection of claims 3, 10, 14-15, 18 and 20-24 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention should be removed in view of the above amendments.

Applicant's invention relates to the discovery that new compositions of cosmetics and pharmaceuticals can be formulated with emulsifiers derived from alkenylsuccinic acid and anhydride derivatives, such as esters thereof when the acid or anhydride group is linked to a mono- and/or polyfunctional alcohol. Cosmetic formulations with and without fragrance prepared with the emulsifier based on the alkenylsuccinic acid or anhydride were found to provide stable emulsions, provided good skin compatibility, and good compatibility with customary cosmetic ingredients. Similarly, pharmaceutical formulations based on emulsifiers of the present invention had good compatibility with pharmaceutical ingredients and provided high stability.

Claims 3, 10, 14-15, 18 and 20-24 stand rejected under 35 USC § 103(a) as being unpatentable over WO 87/03613 ('613). This rejection is respectfully traversed. The '613 reference does not explicitly disclose or exemplify an emulsion comprising the instantly claimed species of emulsifier, nor does the reference relate in any

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manner, nor provide and motivation or suggestion that the species of the emulsifier disclosed in the '613 reference would be suitable in a cosmetic composition with a fragrance or in a pharmaceutical composition comprising a pharmaceutical active ingredient. It is acknowledged that the '613 reference does not disclose directly or indirectly, nor does the reference provide any motivation to formulate such an emulsifier component in an ointment, cream, lotion, gel, or spray. The oil-water emulsions of the '613 reference are disclosed to have utility when combined with functional additives for use in hydraulic fluids, explosives, and acidizing fluids. The '613 reference is at best silent on any compositions of cosmetic formulations containing an emulsifier as claimed by Applicant in amended claim 1, or a pharmaceutical composition as claimed by Applicant in new claim 25. The preamble of a claim is not generally given the effect of a limitation unless it breathes life and meaning into the claim. Applicant's cosmetic composition as claimed in amended claim 1 includes a fragrance which further supports the preamble by that phrase that it can be known that the subject matter defined by the claims is comprised as a cosmetic composition. Similarly new claim 25 reciting a pharmaceutical composition comprising a pharmaceutical active ingredient and the instant emulsifier breathes life into the claim. New claim 29, directed to a fragrance free cosmetic composition being free of fragrance breathes life into the claim.

Regarding *In re Pearson*, 181 USPQ 641, *Pearson* relates to a case where the claim only set forth an intended use for calcium containing compounds of a certain size for reducing abnormalities in peanut growth. There were no additional limitations set forth in the claim which would distinguish it from those of the known art. As stated by the court, "It seems quite clear to us that one of the compositions admitted to be old by the Appellant would not undergo a metamorphosis to a new composition by labeling its container to show that it is suitable for treating peanuts. Such is not the case with the instant claims. The instant claims which include either a fragrance or a pharmaceutical active ingredient, or other customary cosmetic ingredients are clearly not the same as the '613 composition. Therefore, any



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rejection based on In re Pearson (181 USPQ 641) is improper and should be withdrawn.

Regarding the reference to In re Tuominen (213 USPQ 89), Tuominen attempted to recite a sunscreen composition in the preamble of claims directed to a combination of TA and additional ingredients typically found in sunscreen compositions, rather than to TA per se. However, the prior art showed TA to be used with physiologically acceptable materials which were determined to be the same as Tuominen's additional ingredients. Applicant's claimed combination of the instant emulsifier with fragrance in cosmetic compositions, and Applicant's claimed combination of the instant emulsifier with a pharmaceutical active ingredient are different from Tuominen. Neither combination is disclosed in the prior art cited by the examiner. Therefore, any rejection based on In re Tuominen (213 USPQ 89) is improper and should be withdrawn.

Thus, the preamble of Applicant's independent claims 1, 25 and 29 serves to further define the structure of the composition produced, and therefore the body of the claim depends on the preamble for completeness and does not simply recite an intended use. None of the combinations recited in claims 1, 25, and 29 are recited in the prior art. No limitations of a claim which serve to identify the invention should be ignored.

Regarding the Examiner's statement that it would have been obvious to one of ordinary skill in the art to select any species of the genus taught by the '613 reference with the reasonable expectation that any of the species would have similar properties and, thus, the same use as the genus as a whole. To consider this one must first identify the individual having ordinary skill in the art and the classification of the art in which that individual is skilled. The '613 reference is clearly directed to industrial oils and hydraulic fluids. Generally, one skilled in the cosmetic and pharmaceutical arts would not be motivated to look to the art of drilling oils, hydraulic fluids, and heavy industrial acid oils to find a component for cosmetics and pharmaceuticals which will come in contact with human skin. There is nothing in the

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'613 reference to teach or suggest that the emulsifier can be applied to human skin or that the emulsifier is compatible with other cosmetic and pharmaceutical ingredients. Furthermore, in Applicant's Specification, on page 1, [001] Applicant states that the addition of neutralizing agent impairs the emulsifying action in cosmetic systems, while conversely, the reference '613 clearly teaches the addition of such substances including inorganic acids to produce the acidizing oils disclosed in the '613 reference. The scope of the prior art has been defined as that 'reasonably pertinent to the particular problem with which the inventor was involved which is in the cosmetic and pharmaceutical arts. Clearly this is different from art represented by the '613 reference. Furthermore, the '613 reference does not teach or suggest the combinations of the instant invention. To imbue one of ordinary skill in the art with the knowledge of the instant invention, when no prior art reference of record conveys or suggests that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Lastly, the objective of the present invention is to discover acceptable compositions which can be applied to human skin. It might be routine to select different emulsifiers with different emulsifying properties with the ability to form emulsions between oil and water, but whether that resulting emulsion would be suitable for contacting human skin is not predictable. Obvious-to-try is not the same as obviousness.

Therefore, the rejection of claim 10 under 35 USC § 103(a) as being unpatentable in view of WO 87/03613('613) should be withdrawn for the reason that the '613 reference does not teach or suggest the combination claimed by the applicant, and that one skilled in the cosmetic and pharmaceutical art would not be motivated to combine the emulsifier of the '613 reference which is in a non-analogous art, and that any determination that applicants combination was obvious-to-try is based on improper hindsight.



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The rejection of claims 3, 14-15, 18 and 20-24 under 35 USC § 103(a) as being unpatentable in view of WO 87/03613('613) should be withdrawn for the reasons given in support of claim 10 from which they depend.

New claims 25-29 should be allowable for the reasons given hereinabove with reference to amended claim 1.

It is respectfully submitted that, in view of the above remarks, the objection to the Specification, the rejections under 35 U.S.C. 112 and 103(a), should be withdrawn and that this application is in a condition for an allowance of all pending claims. Accordingly, favorable reconsideration and an allowance of all pending claims are courteously solicited.

An early and favorable action is courteously solicited.

Respectfully submitted,



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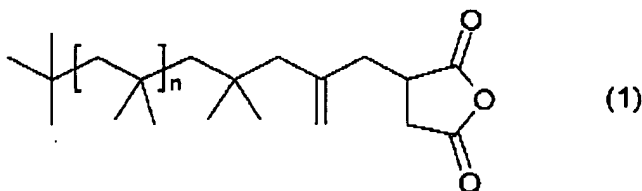
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Marked copy of amended claims

10.(Amended) [The composition as claimed in claim 1] A cosmetic composition comprising a fragrance and containing [, wherein the] an emulsifier [is] comprising an alkenylsuccinic anhydride according to formula (1) and [derivatives] esters thereof,



wherein n is equal to or greater than 4, wherein the alkenylsuccinic anhydride ester is obtained by reaction of the alkenylsuccinic anhydride with a mono- and/or polyfunctional alcohol.

3.(Amended) The cosmetic composition of claim 10 [as claimed in claim 1], wherein the alkenylsuccinic anhydride [the alkyl and/or alkenyl chain] comprises a polyisobutenyl chain obtainable by polymerization of isobutene, or a mixture isobutene and butene.

14.(Amended) The cosmetic composition as claimed in claim [11] 10, wherein the mono- [and] and/or polyfunctional alcohols are selected from the group consisting of monofunctional alcohols having 1 to 30 carbon atoms; ethoxylated and/or propoxylated monoalcohols; fatty alcohol ethoxylate; glycerol; polyglycerols; sugar alcohols; ethylene glycol; propylene glycol; oligomers of ethylene glycol; oligomers of propylene glycol; polyalkylene glycols; random, [blocklike] block copolymers of ethylene oxide and propylene oxide, and mixtures thereof.

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15.(Amended) The cosmetic composition as claimed in claim [14] 10, wherein the mono- and polyfunctional alcohols are selected from the group consisting of methylglycols, glycerol, polyglycerol, polyalkylene glycols, and mixtures thereof

18.(Amended) The cosmetic composition as claimed in claim 10, wherein the [emulsifier is obtainable by reacting alk(en)ylsuccinic anhydrides according to formula (1) with a compound] mono- and polyfunctional alcohols are selected from the group consisting of glycerol, methyltriglycol, polyethylene glycols, and mixtures thereof.

20.(Amended) The cosmetic composition as claimed in claim 10, wherein, in the reaction with the mono- and polyfunctional alcohols [, aminoalcohols and amines, the] a molar ratio of carboxylic anhydride groups to alcohol, aminoalcohol and amine] is in each case 1:0.9 to 1:2.

21.(Amended) The cosmetic composition as claimed in claim 10, wherein, in the reaction with the mono- and polyfunctional alcohols[, aminoalcohols and amines, the] a molar ratio of [carboxylic] anhydride groups to alcohol[, aminoalcohol and amine] is in each case 1:0.9 to 1:1

22.(Amended) The cosmetic composition as claimed in claim [1] 10, wherein the emulsifier comprises 0.1 to 8% by weight of the cosmetic [or pharmaceutical] composition.

23.(Amended) The cosmetic composition as claimed in claim [1] 10, which is in the form of an emulsion.

24.(Amended) The cosmetic composition as claimed in claim [1] 10, which is in the form selected from the group consisting of an ointment, a cream, a lotion, a gel, and a spray.